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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,871	08/06/2003	Noam Kedem	SAND-03062US0	7627

64948 7590 10/27/2009
VIERRA MAGEN/SANDISK CORPORATION
575 MARKET STREET
SUITE 2500
SAN FRANCISCO, CA 94105

EXAMINER

FIGUEROA, FELIX O

ART UNIT	PAPER NUMBER
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2833

MAIL DATE	DELIVERY MODE
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10/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/634,871

Applicant(s)

KEDEM, NOAM

Examiner

Felix O. Figueroa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 13, 18 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 13, 18, 23-27, 29 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 10/21/2009, 08/27/2009.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/16/2009 has been entered.

Election/Restrictions

Newly submitted claim 28 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 28 is directed to an independent Species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 28 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the system enclosure; and the first port open to an exterior of the system enclosure must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13, 8-10, 18 and 23-27 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meng (US 6,231,399).

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Regarding claims 13 and 26, Meng discloses system board (col.2, line 57) fitting within a system enclosure and comprising a connector (10) that includes: a first port (14) situated on the system board; a second port (16) facing inward to an interior of the system board; and a peripheral device (daughter board, not shown) operationally connected to the inward facing port. Meng does not disclose the first port being situated at an outermost exterior edge of the system board and facing outward from the exterior edge. However, Meng discloses that "changes may be made in detail, especially in the matters of shape, size and arrangement of parts within the principles of the invention" (col. 3 lines 3-5). Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the first port situated at an outermost exterior edge of the system board and facing outward from the exterior edge, as a matter of inventors preference and/or to provide greater accessibility to the first port.

It would have been obvious to one skilled in the art at the time the invention was made to make the first port open to (accessible from) an exterior of the system enclosure in order to facilitate connection/replacement of the peripheral device by the user.

Regarding claims 24 and 30, Meng discloses the ports being substantially functionally identical.

Regarding claim 25, Meng discloses the peripheral device (defined by the daughter board with any/all elements attached to it) including a single port for directly operationally connecting the peripheral device to another device; being directly operationally connected to the inward facing port by the single port.

Regarding claim 27, Meng discloses the ports being positioned 180 degrees from each other.

Claims 23, 28 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meng (US 6,231,399) in view of Zhu et al. (US 6,142,833).

Regarding claim 23, Meng, as modified, discloses substantially the claimed invention except for the ports being USB ports. Zhu teaches a system board comprising: a connector (Fig. 1) that includes: a first port (at 21) situated at an exterior edge of the system board and facing outward from said exterior edge, and a second port (at 23); the ports being USB ports, thus providing an efficient and reliable interface between the connector and the peripheral device, by reducing the number of electrical contacts and thus reducing the number of parts that can be damaged. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the ports of Meng as USB ports, as taught by Zhu, in order to provide an efficient and reliable interface between the connector and the peripheral device, by reducing the number of electrical contacts and thus reducing the number of parts that can be damaged.

Response to Arguments

Applicant's arguments filed 09/24/2009 have been fully considered but they are not persuasive.

In response to applicant's argument against Meng, please note that the test for obviousness is not that the claimed invention must be expressly suggested in any one

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or all of the references. Rather, the test is what the teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Additionally, please note that Lelong et al. (US 2004/0033734) shows an example of a motherboard that does not extend the full space of the chassis, in which the connector can be placed on the outermost edge of the motherboard.

In response to Applicant's argument that neither Meng nor Zhu discloses the port being "open to an exterior of the system enclosure for accepting a peripheral device from outside the system enclosure", please note that the rejection does not state that this limitation is shown by Meng or Zhu, but rather that it would have been obvious to one skilled in the art at the time the invention was made to make the first port open to (accessible from) an exterior of the system enclosure in order to facilitate connection/replacement of the peripheral device by the user.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Felix O. Figueroa whose telephone number is (571) 272-2003. The examiner can normally be reached on Mon.-Fri., 10:00am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Renee Luebke can be reached on (571) 272-2009. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Felix O. Figueroa/
Primary Examiner
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